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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,454	07/31/2003	Robert Gee	3123-001	3814

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EXAMINER

BERGIN, JAMES S

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/632,454

Applicant(s)

GEE, ROBERT

Examiner

James S. Bergin

Art Unit

3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 4-9, 11 and 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10 and 12-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 06/10/2005.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of invention 1, Species 1 (having at least two apertures) claims 1-3, 10, 12 and 13-15 in the reply filed on 4/18/2005 is acknowledged (see also the attached interview summary of 6/10/2005). The traversal is on the ground(s) that system and apparatus claims of invention 1, claims 1-3, 10, 12 and 13-15, are not independent and distinct from the method claims of invention 2, claims 4, 5-9, 11 and 16-18. This is not found persuasive because independent method claims 4 and 16 claim that the cartridge is retained in the barrel or firearm while independent system and apparatus claims 1 and 13 do not claim that the cartridge is retained in the barrel or firearm. Additionally, new independent method claim 13 of invention 2 introduces a previously unclaimed inventive feature with the limitation, "*and wherein at least part of said portions of said live ammunition cartridge that are blown out enter at least one of said six apertures to retain said live ammunition cartridge in said firearm and prevent an additional cartridge from being loaded into said firearm*" (a similar concept is also claimed in new method claim 7 of invention 2).

The requirement is still deemed proper and is therefore made FINAL. Non-elected claims 4-9, 11 and 16-18 have been withdrawn as being drawn to the non-elected method invention.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the embodiments comprising a number of apertures other than one aperture must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. This objection to the drawings has been made in light of the amendment filed 11/12/2004 which argues that the number of apertures patentably distinguishes the applicant's amended claims from the previously applied patent to Schuetz et al. (US 5,937,563 A). Thus the number of apertures appears to be seen by the applicant as a critical and distinguishing feature of the invention over the prior art. To be consistent with this interpretation, the embodiments comprising a number of apertures other than one aperture, as in Schuetz et al., each define patentably distinct species of the invention and as such must be separately illustrated. Currently only the embodiment having six apertures is illustrated in figures 1-3.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claim 1 objected to because of the following informalities: in line 2 of the preamble, the examiner suggests that the word "portion" should be removed to be consistent with the previous amendment to claim 1 filed 11/12/2005. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by CA 2,189,904A (Dionne et al., hereinafter, "Dionne").

Regarding claim 1, Dionne discloses a system for preventing the discharge of a live ammunition from a rifle or machine gun comprising: a barrel 6 (fig. 4) having at least two apertures formed therein (page 9, lines 1-4); said at least two apertures being aligned with a portion of the live ammunition cartridge and the longitudinal axis of the barrel; the cartridge and the barrel being cooperatively associated so as to vent pressure created by the firing of the cartridge through the barrel apertures and thereby deprive the cartridge of sufficient pressure to propel the bullet along the longitudinal axis

of the barrel and retain the bullet in the barrel (page 3, lines 14-20; page 7, line 21 – page 8, line 7; figs 4 and 5b).

Regarding claim 2, Dionne's two or more apertures are aligned substantially perpendicularly to the cartridge wall (page 5, lines 1-7, page 7, line 21 – page 8, line 7; page 9, lines 1-5; and the top view of fig. 4).

Regarding claim 3, the portion of the cartridge opposite the two or more of Dionne's barrel apertures 11a is inherently rendered the weakest part of the cartridge because it does not have the support of the barrel surrounding it and thus ruptures under the pressure and vents the gas through the cartridge wall and through the barrel apertures (page 8, lines 1-7; fig. 4).

Regarding claim 10, Dionne's at least two apertures are located on the barrel such that pressure is dispersed to at least one of the two sides of the rifle or machine gun (page 9, lines 1-4; fig. 4).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 12 and 13-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over CA 2,189,904A (Dionne et al., hereinafter, "Dionne").

Regarding claims 12 and 13, Dionne discloses a system for preventing the discharge of live ammunition from a rifle or machine gun as discussed above. Dionne states on page 9, lines 1-5, *"that two or more such orifices may be employed at spaced locations around the circumference of the chamber 3"*. This disclosure inherently includes at least up to six orifices at spaced locations around the circumference of Dionne's chamber 3.

If for some reason the applicant believes that two or more orifices does not include six orifices, then it would have been obvious to one having ordinary skill in the art at the time the invention was made to select six orifices in Dionne's barrel, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). (In this case the result effective variable would be the number of orifices selected and spaced around the circumference of Dionne's barrel).

Regarding claim 14, Dionne's two or more orifices are aligned substantially perpendicularly to the cartridge wall (page 5, lines 1-7, page 7, line 21 – page 8, line 7; and page 9, lines 1-5; and fig. 4) and the same would hold true for an embodiment of Dionne's barrel having six orifices spaced around its circumference.

Regarding claim 15, the portion of the cartridge opposite the two or more of Dionne's barrel apertures 11a is inherently rendered the weakest part of the cartridge because it does not have the support of the barrel surrounding it and thus ruptures under the pressure and vents the gas through the cartridge wall and through the barrel apertures (page 8, lines 1-7; fig. 4).

Response to Arguments

8. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Heitz (US 5,565,642 A); Mauch et al. (US 5,475,940 A); Reynolds et al. (US 6,202,533 B1) and Chee et al. (US 6,481,144 B1).

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Bergin whose telephone number is 571-272-

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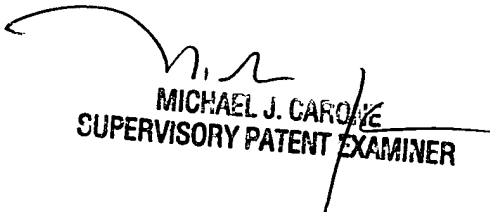
6872. The examiner can normally be reached on Monday - Wednesday and Friday,
8.30 - 5.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571-272-6873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James S. Bergin



MICHAEL J. CARONE
SUPERVISORY PATENT EXAMINER